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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,250	04/26/2001	Rebecca Paraless	875.006US2	7359

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EXAMINER

RAMIREZ, DELIA M

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 11/01/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/843,250

Applicant(s)

PARALES ET AL.

Examiner

Delia M. Ramirez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 30-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Status of the Application

Claims 1-13, 30-38 are pending.

It is noted that the examination of the instant application has been assigned to a different Examiner in Group Art Unit 1652.

Applicant's election without traverse of Group I, claims 1-13 and 30-37 drawn to NDO polypeptides, and the election of SEQ ID NO: 2 and position 352 as the species, in Paper No. 11, filed on 8/12/2002 is acknowledged.

Upon further consideration, the previous restriction requirement and request for an election of species is withdrawn and a supplemental restriction requirement follows, in view of the fact that the claims read on patentably distinct inventions within the elected group. This supplemental requirement is at the discretion of the examiner (see MPEP 802 and 37 CFR 1.142) and is deemed appropriate and necessary in view of the plurality of claimed patentably distinct inventions.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12, 31-37, drawn in part to a NDO complex comprising the alpha subunit as set forth in SEQ ID NO: 2, 32, 33, 34, 35 or 36, classified in class 435, subclass 190.

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II-XIII. Claims 1-8, 11-13, 31-37 drawn in part to a NDO complex comprising the alpha subunits as set forth in SEQ ID NO: 14-24, respectively, classified in class 435, subclass 190.

XIV-XXX. Claim 38, drawn in part to the polynucleotides of SEQ ID NO: 37, 40-55, respectively, classified in class 536, subclass 22.1.

The inventions are distinct, each from the other because of the following reasons:

2. Groups I-XXX each comprise a chemically unrelated structure capable of separate manufacture, use, and effect. The DNA in Groups XIV-XXX comprises a nucleic acid sequence, whereas the proteins of Groups I-XIII each comprise an unrelated amino acid sequence. The DNA can be used as a hybridization probe or in gene therapy whereas the proteins from Groups I-XIII can be used to make antibodies, or in therapeutic or diagnostic methods (e.g. in screening). Further, the proteins of Groups I-XIII can be prepared by processes which do not require the DNA of Groups XIV-XXX., such as by chemical synthesis, or by isolation and purification from natural sources.
3. The proteins of Groups I-XIII are related by virtue of being NDO complexes. However, they are patentably distinct inventions for the following reasons. Groups I-XIII are directed to proteins with different and unrelated amino acid sequences, structures, use, and are not required one for the other. Furthermore, a search and examination of all these Groups would result in an undue burden since the searches are not co-extensive. Accordingly, restriction is deemed proper.

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4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for all groups is not co-extensive, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement can be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Certain papers related to this application may be submitted to Art Unit 1652 by facsimile transmission. The FAX number is (703) 308-4556. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If Applicant submits a paper by FAX, the original copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (703) 306-0288. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy can be reached on (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Delia M. Ramirez, Ph.D.
Patent Examiner
Art Unit 1652

DR
October 1, 2002


PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
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